

**DOCKETED****JAN 18 2002****UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,887	04/20/2001	Kevin R. Willett	85939.000193	4285

23387 7590 01/15/2002

Stephen B. Salai, Esq.  
Harter Secrest and Emery LLP  
1600 Bausch & Lomb Place  
Rochester, NY 14604-2711

EXAMINER

UHLIR, NIKOLAS J

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 01/15/2002

*Response: 4/15/02*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/839,887

Applicant(s)

WILLETT, KEVIN R.

Examiner

Nikolas J. Uhler

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 27-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,2,5
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-26, drawn to an automotive weatherseal, classified in class 428, subclass 332.
  - II. Claims 27-32, drawn to a method for forming a surface film, classified in class 427, subclass 485.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the coating could be formed via powder coating without an applied electrical potential.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. As a prerequisite for obtaining special status, the applicant is required to elect an invention without traverse in the event that a restriction requirement is deemed appropriate by the examiner. As indicated questionnaire enclosed within the petition to

make special, dated 10/1/01, the applicant elected invention I, claims 1-26, without traverse.

***Specification***

5. The disclosure is objected to because of the following informalities: There is no brief description of figure 11 in the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The statement "a thickness between approximately 0.05 and 0.2 mm" in claim 3 is not further limiting because "approximately" indicates that the thickness can have a value slightly more or less than the indicated range. Because the range can exceed .2 mm, claim 3 contains limitations that are broader than the limitations stated in the independent claim upon which it is dependent (claim 1). Therefore rejection is appropriate under 35 U.S.C 112, paragraph 2.

In the instant case, removal of the term "approximately" is sufficient to overcome this rejection.

***Claim Rejections - 35 USC § 102/103***

Art Unit: 1773

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5-7, 9, 12-14, and 16-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ford et al. (US5545448) as evidenced by Cook (US6024906).

The limitation that the coating of the invention be formed from a colliquified powder, as required by claims 5-7, 9, 10, 12-14, and 16-26, is a product-by-process limitation and does not appear to be further limiting in so far as the structure of the product is concerned. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP § 2113.

Art Unit: 1773

Ford et al. teaches a colored extruded strip for use as a weather seal on a motor vehicle (Column 1, lines 41-46). This weather seal is comprises a composite door seal and static edge trim or carrier portion as shown in figure 1 (column 1, lines 20-23). The seal portion is extruded from elastomeric ethylene-propylene-diene polymers (EPDM), which are known thermosetting materials (Column 2 lines 20-24). EPDM, as evidenced by Cook, is inherently resilient (Cook column 4, lines 63-66, and column 5, lines 42-45). Ford et al. teaches that the static edge trim portion is formed of a colored plastic material (column 2, lines 28-30). This includes thermoplastics. In addition, the static trim portion can incorporate a metallic formed carrier 7, which upon inspection of the drawings is substantially u-shaped (Column 2, lines 24-25). Ford et al. teaches that the whole outer surface area of the combination seal and edge trim is covered with a colored spray coating (column 3, lines 30-33). This coating is a polyurethane material formulated to provide good adhesion and flexibility (column 3 lines 26-30). It is well known that polyurethane's can be either thermosetting or thermoplastic polymers. In addition, this coating is available in different levels of glossiness (Column 3 lines 54-56). This coating is formulated to provide excellent adhesion to both substrates (column 3, lines 30-33). This coated edge/seal trim article is described for use as a sealing device for a traditional corner joint in a vehicle door (column 3 line 66, column 4 line 3).

11. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cook (US6024906).

Cook teaches a composite extrusion which is suitable for use as a window channel or seal in the automotive industry (Column 3 lines 15-20). The main body of this

Art Unit: 1773

composite extrusion comprises EPDM rubber (Column 4, lines 63-67). EPDM rubber is an inherently resilient material (column 4, lines 63-66, and column 5, lines 42-45). A layer of thermoplastics material, ideally EPDM modified polypropylene, is extruded onto several surface areas of the main body (Column 5, lines 8-17). Cook teaches that the EPDM rubber is a thermoset material, whereas polypropylene is a thermoplastic material (Column 4 lines 16-36).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-4, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al. as evidenced by Cook (US6024906), in view of Chihara et al. (US5115007).

14. The limitation that the coating of the invention be formed from a colliquesfied powder, as required by claims 1-4, 8, and 15, is a product-by-process limitation and does not appear to be further limiting in so far as the structure of the product is concerned. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

Art Unit: 1773

unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP § 2113.

Ford et al. teaches a colored extruded strip for use as a weather seal on a motor vehicle (Column 1, lines 41-46). This weather seal is comprises a composite door seal and static edge trim or carrier portion as shown in figure 1 (column 1, lines 20-23). The seal portion is extruded from elastomeric ethylene-propylene-diene polymers (EPDM), which are known thermosetting materials (Column 2 lines 20-24). EPDM, as evidenced by Cook, is inherently resilient (Cook column 4, lines 63-66, and column 5, lines 42-45). Ford et al. teaches that the static edge trim portion is formed of a colored plastic material (column 2, lines 28-30). This includes thermoplastics. In addition, the static trim portion can incorporate a metallic formed carrier (Column 2, lines 24-25). Ford et al. teaches that the whole outer surface area of the combination seal and edge trim is covered with a colored spray coating (column 3, lines 30-33). This coating is a polyurethane material formulated to provide good adhesion and flexibility (column 3 lines 26-30).

Ford et al. does not teach a automotive weather seal which has a surface film coating that is .05mm-.2mm thick (2-8 mils) or less.

Chihara teaches an abrasion resistant polyurethane blend which is suitable for use as a uniform coating on an automotive glass run channel comprised of EPDM rubber (Column 2 lines 12-29). This compound can be applied to the EPDM substrate without a primer coating and is weather resistant (column 7, lines 8-50). At a coating thickness of .2 mils, the coating has an abrasion resistance of 25,500 cycles. At a



Art Unit: 1773

thickness of .45 mils (11.5 microns), the coating has an abrasion resistance of 29,500 cycles (table 3). At a thickness of .6 mils (15.5 microns), the coating has an abrasion resistance of 30,000 cycles (Table 3). Finally, at a thickness of 1.15 mils (29 microns), the coating has an abrasion resistance of 34,000 cycles (column 11, lines 32-35). Thus it is logical to assume that abrasion resistance is proportional to film thickness, wherein thicker films exhibit more resistance to abrasion and thinner films exhibit less resistance. Although Chihara does not explicitly teach a coating thickness between 2-8 mils, there is no statement directly precluding the use of a coating of this thickness. Therefore it is logical to believe that a coating thickness between 2-8 mils would show exceptionally high abrasion resistance and would be suitable for applications where a high durability coating was desired.

Therefore it would have been obvious to one with skill in the art at the time the invention was made to substitute up to a 2-8 mil thick coating of the polyurethane composition described by Chihara for the polyurethane coating on the weather seal taught by Ford et al.

One would have been motivated to make this substitution due to the exceptionally high wear resistance one would expect to see as a result.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhler whose telephone number is 703-305-0179. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

Art Unit: 1773

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0389.

*nju*

nju

January 2, 2002

*Paul Thibodeau*

Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700